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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Appellant(s): TRAYLOR, MARC

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Technology Center 2600

Eric Whitesell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 20, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,729,158	Nagy	4-1973

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy '158.

With respect to claims 1, 4, 7, 11-14, 18 and 19, Nagy '158 discloses a holder (figure 1) comprising a clamp (28, 30, 32, 33 and 34, figure 1), a magnet (48, figure 1), a magnet holder (40, 42, 44 and 46, figure 1) and a resilient member/length of resilient

material/spring (figure 1) having a proximal portion (figure 1) attached to the clamp and a distal portion (figure 1) attached to the magnet; wherein the resilient member (24), the magnet holder (46) and at least a portion of the clamp (28, 30, 32, figure 2) constitute a single molded structure; wherein the holder further comprises a paint can (6) and a paintbrush (10); wherein the resilient member (24) inherently has a force constant which produces some displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that a paintbrush attached to the magnet does not slide off the magnet. Regarding claims 2, 5, 8 and 15, the member inherently acts as a spring whenever a force is applied perpendicularly to it. With respect to claims 3, 6, 9, 16, member 24 is inherently resilient due to the material it is made from.

Regarding claims 10, 17 and 20, Nagy '158 fails to specifically teach the resilient member to limit acceleration of an object attached thereto to no more than 0.75 g. It would have been obvious to an ordinary artisan at the time the invention was made that the resilient member could be selected so as to limit acceleration of the paintbrush to any number of certain degrees, and any specific degree, including to no more than 0.75 g would clearly be a design choice (so as to satisfy specific user preferences) and hence is not considered patentable.

(11) Response to Argument

Issue 1

The appellant contends that the Examiner erred in alleging the leg (24) of Nagy '158 is equivalent to the claimed resilient member. Referring to lines 52-53 of column 1 of Nagy '158, it is clearly stated that the leg is "bendable". Hence, leg (24) is in fact resilient.

Continuing, the applicant alleges that the Examiner stated it would have been obvious to an ordinary artisan to "select the vertical leg (24) in Nagy to limit acceleration of the paintbrush" ("limiting acceleration of the paintbrush only being recited in dependent claims 10, 17 and 20). To begin, with respect to claims 1-9, 11-16, 18 and 19, the Examiner first indicated that the resilient member (23) inherently has a force constant which produces some displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that a paintbrush attached to the magnet does not slide off the magnet. Because the resilient member of Nagy '158 is "*bendable flat faced metal*" (column 1, lines 52-53), without a doubt, it has a force constant. As far as that force constant specifically being selected to produce a displacement of the distal portion when subjected to a shock *so that the paintbrush attached to the magnet does not slide off the magnet*, Nagy '158 also inherently suggests such a feature.

More specifically, for instance, in the invention of Nagy '158, when the paintbrush is attached to the magnet, there is obviously, clearly, and inherently *some* mechanical shock applied to the paintbrush, and there is obviously, clearly, and inherently *some* displacement of the distal portion upon the mechanical shock applied to the paintbrush,

yet, the paintbrush obviously does not slide off the magnet, since, for instance, in figure 1 of Nagy '158, the paintbrush is in fact attached to the magnet. Therefore, Nagy '158 does in fact teach the resilient member to have some force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet. Further, acceleration of the paintbrush is inherently limited to *some* degree by the resilient member (24) since, as previously mentioned, the paintbrush is attached to the resilient member (24) in figure 1 of Nagy '158.

Continuing, on the bottom of page 4 of the Brief, the appellant states that since the vertical orientation of the member (24) is nearly parallel to the direction in which the paint can would be picked up or set down, most of the force between the brush and the can would act to apply compression or tension in the metal strap, and thus no displacement would occur that could reduce acceleration of the paintbrush. The Examiner surely disagrees. With reference to figure 2 of Nagy '158, the member (24) is clearly not perfectly vertical. Further, as previously mentioned, because the member (24) is clearly resilient, when the brush is attached to the holder, there must be *some* displacement of the distal portion of the member (24). The brush does *not* fall off during such displacement, and hence, acceleration of the brush must inherently be reduced.

Again, the applicant is making repeated allegations that the Examiner somehow modified the member (24) of Nagy '158 to be resilient and to produce a displacement of the distal portion of the member (24) and the paintbrush. The Examiner is making no

such modifications. Such features are inherently taught in Nagy '158 for previously described reasons.

Regarding the first full paragraph of page 5 of the Brief, the appellant contends that the Examiner failed to teach how the resilient member could be selected so as to limit acceleration of the paintbrush to any number of certain degrees so as to be performed with a reasonable expectation of success. As previously described, Nagy '158 already teaches a resilient member that produces a displacement of the paintbrush so as to prevent the brush from, for instance, sliding off the magnet and falling into the paint in the paint can. Hence, Nagy '158 already inherently teaches that the resilient member limits acceleration of the brush to *some* degree. Although claims 10, 17 and 20 do not specifically mention why a degree such as 0.75 g is selected, it is mentioned in the specification (bottom of page 7) that such a degree is selected so as to keep the brush on the magnet and prevent it from falling into the paint. The only difference in the Examiner's mind between Nagy '158 and the present invention is that Nagy '158 failed to *specifically* teach that the resilient member limit accelerations of the paintbrush to no more than 0.75 g. The applicant's reasoning for such a specific value is to accomplish a feature that Nagy '158 *already inherently teaches*. An ordinary artisan could easily select any number of resilient members that would limit acceleration of an object or paintbrush attached thereto to any number of various degrees, including 0.75g, and hence is not considered patentable.

Issue 2

The applicant contends that the force constant is not inherent in Nagy '158, and alleges that the Examiner essentially argued, "any displacement of the distal portion is sufficient to prevent the paintbrush from falling off the magnet." The applicant goes on to explain how such is not true, and then continues on page 6 of the Brief by describing the "rigid bracket" from the specification.

First off, the Examiner never recited, "any displacement... ...is sufficient to prevent the paintbrush from falling off the magnet." This is just not true. Quite possibly, if the paintbrush, holder and paint can were dropped off the 70th floor of the Sears Tower, the paintbrush would fall off the magnet. The Examiner merely stated that as shown in figure 1, the paintbrush is in fact attached to the magnet. While the brush is being attached, there must have been *some* displacement of the distal portion of the resilient member that obviously prevented the brush from falling into the paint in at least one instance.

Continuing, it is not known why the applicant is making reference to a "rigid bracket," nor why the applicant is referring to the member (24) as being a "rigid bracket." Nagy '158 *clearly* taught the member (24) to be *bendable*.

On the bottom of page 6 through the middle of page 8, the applicant quoted case law discussing a characteristic that "may" be present. There is no "may" with regards to Nagy '158. All features of the claims, with the exception of the 0.75g value of claims 10, 17 and 20, are explicitly or inherently taught.

Issue 3

The appellant contends that the Examiner erred on page 4 (assuming in the previous office action) in dismissing the selection of the claimed force constant as a design choice or user preference. The Examiner never dismissed the claimed force constant as a design choice or user preference. However, the Examiner did in fact dismiss the selection of the resilient member to limit acceleration of the brush to no more than 0.75g as a design choice or user preference.

Although Nagy '158 did not explicitly recognize the supposed need to mechanically isolate the brush and magnet from the can, as previously mentioned, Nagy '158 already has taught the member (24) to be resilient, and the mentioned displacement of the distal end of the member (24) *inherently* occurs while preventing the brush from falling off the member (see figure 1, the brush is in fact attached to the member 24).

On the top of page 10 of the Brief, the appellant contends that since Nagy does not disclose an arrangement of the vertical leg (24) that is perpendicular to the direction of force as alleged by the rejection, there is insufficient support to sustain the rejection of claims 1-20 under 35 U.S.C. 103. Absolutely none of the appellant's claims even mention the word "perpendicular". Hence, such a discussion has absolutely no bearing on the patentability of the claims.

The rest of page 10 repeats the discussion of member (24) being "rigid," which is not true, and discusses the supposed lack of Nagy '158 to teach the member (24) to

have a force constant, which is not true. Further, on the bottom of page 10, the appellant discusses the value of 0.75g that has already been addressed.

Issue 4

The appellant continues to allege that the Examiner modified Nagy '158 to have a selected force constant. Again, as repeated numerous times, Nagy '158 inherently teaches such a force constant, there is no modification. The Examiner did in fact show that the feature is inherent in Nagy '158.

Arguments Supporting Separate Patentability of Claims on appeal

On pages 11 and 12, the appellant alleges that the resilient member, magnet holder and at least a portion of the clamp do not constitute a single molded structure. Such is not true. The Examiner is referring to the magnet holder as member 46 (it inherently "holds" the magnet, without it the magnet could easily be disengaged), the resilient member as 24, and a portion of the clamp as 28, 30 and 32, generally. All three of these members constitute a "single molded structure." See figures 1 and 2 of Nagy '158.

It is interpreted that all other allegations and arguments have been addressed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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April 22, 2005

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